

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Timothy Tak Chun Yip *et al.*
Title: **SERUM BIOMARKERS IN LUNG CANCER**
Appl. No.: 10/539,291
Filing Date: 4/7/2006
Examiner: Mark Halvorson
Art Unit: 1642
Confirmation
Number: 2464

RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to an Office Action mailed March 31, 2008, Applicants hereby elect Group 10, claims 84-87, drawn to software for qualifying lung carcinoma in a subject. They reserve the right to file a divisional application directed to subject matter of any non-elected claim.

This election is made with traverse only to the extent that Examiner Halvorson intends something other than a species election when he states that applicants "must select one protein or combination of proteins to be examined for the elected group" (action at page 4, second full paragraph). For purposes of a complete response, applicants choose the combination of WM-477, WM-59, and WM-19 (see paragraph 0019 of the published application), upon which species each of the elected claims reads.

Limiting applicants' elected invention to "one protein or a combination of proteins," if that is the examiner's intention, contravenes current PTO policy in relation to the process claims and their equivalent, the software (algorithm) claims of elected Group 10. Pursuant to that policy, "when the Markush group occurs in a claim reciting *a process* or a combination (not a single compound), it is sufficient [for joinder] if the members of the group are disclosed in the specification *to possess at least one property in common which is mainly responsible for their function in the claimed relationship*, and it is clear from their very nature or from the prior

art that all of them possess this property." MPEP § 2173.05(h) (emphasis added). For a "Markush-type claim," moreover,

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all of the members of the Markush group . . . , even though they may be directed to independent and distinct inventions.

MPEP § 803.02.

There has been no showing of record that search and examination relating to all of the recited biomarkers in this context would present a "serious burden." Indeed, applicants submit that no such burden pertains, since dealing with the markers together would entail nothing more than a consideration of information on industrial-scale, adsorptive chromatography, a technical field certainly relevant to the claimed technology. By the same token, amenability to fractionation via absorptive chromatography and a correlation to lung carcinoma are properties that, as the specification discloses (see, e.g., paragraphs 0035 – 0050 of the published application), the markers by their very nature possess in common.


Applicant submits, therefore, that no restriction properly lies against the separate biomarkers as recited or any permutations thereof. It necessarily follows that the subject matter of the elected claims should be considered *in toto* during this prosecution.

With this understanding, applicants await receipt of the initial Office action on the merits. Examiner Halvorson is invited to contact the undersigned directly, should he feel that weighing of any particular issue would advance the present case.

The Commissioner also is hereby authorized to charge any additional fees, which may be required regarding this application under 37 CFR §§ 1.16-1.17, and to credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment accompany this response, then the Commissioner is authorized to charge the unpaid amount to the same deposit account.

Respectfully submitted,

Date 30 April 2008

By 

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